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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,702	09/13/2006	Richard Martin	05-1128-A1	2568

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MCDONNELL BOEHNEN HULBERT @ BERGHOFF LLP
300 SOUTH WACKER DRIVE
SUITE 3100
CHICAGO, IL 60606

EXAMINER	
COLEMAN, BRENDA LIBBY	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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MCDONNELL BOEHNEN HULBERT @ BERGHOFF LLP
300 SOUTH WACKER DRIVE
SUITE 3100
CHICAGO IL 60606

In re Application of :
Martin et al.
Serial No.: 10/565,702 : Decision on Petition
Filed: January 23, 2006
Attorney Docket No.: **05-1128-A1** :

This letter is in response to the petition filed under 37 C.F.R. § 1.181 filed on December 10, 2010, to withdraw the final rejection of September 30, 2010.

BACKGROUND

A 5-way restriction requirement and a tentative election of a single species was mailed to applicants on August 7, 2009.

Applicants made an election to the restriction requirement and an election to a single species on February 5, 2010.

The examiner mailed to applicants a non-final Office action on April 14, 2010. Claims 1-5 and 32-48 were rejected under 35 USC 112, first paragraph, as being non-enabling. Claims 1-5 and 32-48 were rejected under 35 USC 112, second paragraph, as indefinite. Claims 6-31 were withdrawn from consideration.

On July 14, 2010, applicants submitted an amendment with remarks and amendments to the claims.

The examiner mailed to applicants a final Office action on September 30, 2010. Claim 1-5, 32, 33, 34-42, 44, 46 and 48 were rejected under 35 USC 112, second paragraph, as being indefinite. Claims 34-42, 44 and 48 were rejected under 35 USC 112, first paragraph, as being non-enabling. Claims 43 and 45 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

On November 24, 2010, applicants submitted an after final amendment including claim amendments.

On December 2, 2010, the examiner mailed to applicants an advisory action indicating that the after final amendment would not be entered because new issues would be raised requiring further consideration and/or search.

On December 10, 2010, applicants submitted the petition currently under review.

DISCUSSION

The petition and file history have been carefully considered.

In the petition, applicants "respectfully submit that the search and examination procedure employed was inconsistent with Patent Office guidelines and deprived the applicants of their right to a full search of the claims. Therefore, the final rejection should be withdrawn and the claims searched to their full extent permitted by the prior art, up to the full scope of the claims."

Specifically, applicants argue "In the present application, examination has been conducted only on the elected species, as stated by the Office in the December 2010 Advisory Action; all claims drawn to unelected species (claims 6-31) were withdrawn by the Office even though no prior art rejections were made. The applicants respectfully submit this is in violation of the PTO requirement of compact examination (e.g., MPEP § 707.07(g) and MPEP § 2106(11) ("Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement.")), and MPEP § 803.02."

Applicants also argue the proper procedure for examining Markush claims is set forth in MPEP 803.02, a search of a Markush claim (which may include independent and distinct inventions) is to begin with the elected species and, if the species is allowable over the prior art, expanded to the full scope of the claims allowable over the prior art. The search may be stopped short of the full scope only if prior art is found that renders the claims unpatentable as anticipated or obvious; rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species. This is consistent with the policy of compact prosecution, which requires simultaneous examination of the claims as to all bases of patentability.

Applicants also point out "Because an improper search and examination procedure was employed and the applicants were denied the search to which they were entitled, the applicants respectfully submit that the Office should withdraw the final rejection and search the claims (including claims 6-31) to the full extent permitted by the prior art, up to the full scope of the claims. Should prior art be identified, a non-final action would be appropriate to permit the applicants an opportunity to amend the claims and/or argue in favor of patentability. If the prior art rejection is thereby overcome, the search should be expanded once again, as is consistent with the example provided in MPEP § 803.02."

Applicants' arguments have been accorded careful consideration and are persuasive. Accordingly, prosecution will be reopened.

DECISION

The petition is **GRANTED**.

The Office action mailed September 30, 2010 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. The after final amendment of November 24, 2010 will also be entered. This application will be forwarded to the examiner to take an action consistent with the decision herein.

The application will be forwarded to the examiner for preparation of a action(s) wherein proper search and examination procedures are followed.

Should there be any questions about this decision, please contact Special Program Examiner Marianne Seidel, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Remy Yucel
Acting Director, Technology Center 1600